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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,480

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Alejandro Wiechers

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INTELLECTUAL PROPERTY ADMINISTRATION

FORT COLLINS, CO 80527-2400

EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/635,480	Applicant(s) WIECHERS, ALEJANDRO	
	Examiner Mark R. Milia	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12-22 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium.

Claims 12-22, while defining a program product, do not define a "computer-readable medium" and is thus non-statutory for that reasons. A program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody a "computer-readable medium" for storing the program in order to make the claim statutory.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 8, 10-15, 19, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0078160 to Kemp et al.

Regarding claims 1, 12, and 23, Kemp discloses a method, program, and system of managing workflow in a commercial printing environment including a designer location and a print service provider location, said method comprising: creating a press ready file at the designer location using updated device configuration information from the print service provider location by encapsulating a plurality of files associated with a print job created at the designer location (see Figs. 3 and 4 and paragraphs 12, 36, 43, 48, 52-58, 60-62, 69, and 84-87), submitting said press ready file to the print service provider location via an electronic network (see Figs. 4 and 10 and paragraphs 52-58 and 84-87), and performing at least one of automated printing, finishing, packaging and shipping using said press ready file (see paragraphs 40-41 and 64).

Regarding claims 2 and 13, Kemp further discloses wherein after said step of submitting, said method further comprises a step of verifying, at said print service provider location, that said press ready file will be produced at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure production substantially as designed (see paragraphs 84-87).

Regarding claims 3 and 14, Kemp further discloses wherein in said step of creating a press ready file at the designer location, said plurality of encapsulated files includes a file created by the designer containing the substance of the print job and the corresponding images and fonts (see paragraphs 48-54, 56-58, and 69-72).

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Regarding claims 4 and 15, Kemp further discloses wherein in said step of creating a press ready file at the designer location, said plurality of encapsulated files includes a job ticket (see paragraphs 48, 53, 56, 69-71, and 84-85).

Regarding claims 8 and 19, Kemp further discloses wherein said step of creating a press ready file at the designer location further comprises performing automated remote finishing setup of said press ready file to remotely select the desired finishing options for said press ready file when printed at said print service provider location and to prepare finishing instructions to effect the same and wherein said plurality of encapsulated files includes said finishing instructions (see paragraphs 41, 67, 69, and 85).

Regarding claims 10 and 21, Kemp further discloses wherein said step of creating a press ready file at the designer location further comprises performing automated remote packaging setup of said press ready file to remotely select the desired packaging options for said press ready file when printed at said print service provider location and to prepare packaging instructions to effect the same and wherein said plurality of encapsulated files includes said packaging instructions (see paragraphs 41, 64, 67, 69, and 85).

Regarding claims 11 and 22, Kemp further discloses wherein said step of creating a press ready file at the designer location further comprises performing automated remote shipping setup of said press ready file to remotely select the desired shipping options for said press ready file when printed at said print service provider location and to prepare shipping instructions to effect the same and wherein said

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plurality of encapsulated files includes said shipping instructions (see paragraphs 41, 64, 67, 69, and 85).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp as applied to claims 1 and 12 above, and further in view of U.S. Patent Application Publication No. 2002/0101608 to Whitmarsh, as cited in the Information Disclosure Statement dated 8/7/03.

Kemp discloses creating a press ready file at the designer location using updated device configuration information from the print service provider location by encapsulating a plurality of files associated with a print job created at the designer location (see Figs. 3 and 4 and paragraphs 12, 36, 43, 48, 52-58, 60-62, 69, and 84-87) and two-sided printing (see Fig. 6B).

Kemp does not disclose expressly wherein in said step of creating a press ready file at the designer location, said plurality of encapsulated files includes an imposition information file.

Whitmarsh discloses selecting imposition print options (see Fig. 9 and paragraphs 41-42).

Kemp & Whitmarsh are combinable because they are from the same field of endeavor, printing over a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the imposition print options, as described by Whitmarsh, with the system of Kemp.

The suggestion/motivation for doing so would have been ensure print job accuracy by specifying the arrangement and spacing of the print job. The prepress step of imposition is well known and used in the art, as seen in the reference of Whitmarsh and several other references list in the Information Disclosure Statement dated 8/7/03, and is alluded to in the reference of Kemp (Fig. 6B, two-sided printing tab).

Therefore, it would have been obvious to combine Whitmarsh with Kemp to obtain the invention as specified in claims 6 and 17.

6. Claims 5, 7, 9, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp.

Kemp discloses the ability to print a document to a local printer (print a proof) and/or send the document to a service provider (see paragraphs 48 and 57).

Regarding claims 5 and 16, Kemp does not disclose expressly wherein in said step of creating a press ready file at the designer location, said plurality of encapsulated files includes a remote proof file.

However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a remote proof file because it is well known in the art to proof a document to ensure that the final print is accurate to what is desired by the user/designer/customer. Proofing is commonly used in the art, as seen in several references listed in the IDS dated 8/7/03.

Regarding claims 7 and 18, Kemp does not disclose expressly wherein in said step of creating a press ready file at the designer location, said plurality of encapsulated files includes an imposition proof in electronic form.

However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to include an imposition proof file because it is well known in the art to proof a document to ensure that the final print is accurate to what is desired by the user/designer/customer. Proofing is commonly used in the art, as seen in several references listed in the IDS dated 8/7/03.

Regarding claims 9 and 20, Kemp does not disclose expressly wherein in said step of creating a press ready file at the designer location, said plurality of encapsulated files includes an electronic image of a finishing mock-up.

However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to include an electronic image of a finishing mock-up because it is well known in the art to proof a document to ensure that the final print is accurate to what is desired by the user/designer/customer. Proofing is commonly used in the art, as seen in several references listed in the IDS dated 8/7/03.



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Therefore, it would have been obvious to combine including proof and mock-up files in the plurality of files associated with the print job with Kemp to obtain the invention as specified in claims 5, 7, 9, 16, 18, and 20.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art please refer to the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia  
Examiner  
Art Unit 2625



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